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09/703,351	10/31/2000	Anders Borgstrom	34650-604PT	3222
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JENKENS & GILCHRIST, PC 1445 ROSS AVENUE SUITE 3200 DALLAS, TX 75202				
			EXAMINER LE, BRIAN Q	
			ART UNIT 2623	PAPER NUMBER 9

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/703,351

Applicant(s)

BORGSTROM ET AL.

Examiner

Brian Q Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5 and 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

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***Specification***

1. The specification is objected to because of the following informalities: The U.S. Patent Application Serial Numbers on pages 2 and 3 should be entered.

Appropriate correction is required.

***Claim Objections***

2. Claim 21 is objected to because these claims are very difficult to understand due to the use of confusing language. One skilled in the art does not understand the concept of “identifying a portion of the address pattern adjacent to the electronic reading device”, explanation is needed to further elaborate on how the address pattern can possibly adjacent to an apparatus/device.

Appropriate correction is required. The prior art rejection based on the Examiner’s best understanding.

***Drawings***

3. The drawing is of insufficient quality for publication (Note handwritten portions).

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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5. Claims 1-8, 13-15, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Lazzouni U.S. Patent No. 5,652,412.

Regarding claim 1, Lazzouni teaches an electronic reading device (abstract), comprising:

A reading sensor for detecting a portion of an address pattern on a formatted surface

(FIG. 9, element 204);

A processor (pre-processor/processor/microprocessor) (FIG. 11, element 264 and column 4, lines 30-40) for identifying the detected portion of the address pattern as being within an electronic reading device configuration area and for converting position data received from the reading sensor into a configuration setting (column 2, lines 60-67).

For claim 2, Lazzouni further teaches the electronic reading device wherein the electronic reading device configuration area comprises an electronic reading device configuration form (encoded paper) (FIG. 4 and column 3, lines 49-50).

Referring claim 3, Lazzouni also teaches the electronic reading device further comprising a memory for storing (storing unit) (column 3, lines 27-34) the configuration setting.

Regarding claim 4, Lazzouni teaches the electronic reading device wherein the processor converts the position data into the configuration setting using a configuration application (pen/stylus that reads and transfers the information) (column 4, lines 51-65).

For claim 5, Lazzouni discloses the electronic reading device wherein the position data corresponds to handwritten information written with the electronic reading device, the conversion of the position data into the configuration setting performed using handwriting recognition (column 5, lines 1-12).

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Regarding claim 6, Lazzouni teaches the electronic wherein the handwritten information is entered in field of the electronic reading device configuration area that corresponds to the configuration setting (FIG. 4 and FIG. 5A-D).

For claim 7, Lazzouni further discloses the electronic reading device wherein the position data is associated with at least one of a plurality of fields (FIG. 4 and FIG. 5A-D), the processor operating to convert a detection of a portion of the address pattern within the at least one of the fields into a configuration setting corresponding to the at least one field (column 9, lines 1-12 and column 4, lines 30-40).

Regarding claim 8, Lazzouni further teaches the electronic reading device wherein each of the plurality of fields corresponds to a different alphanumeric character (FIG. 1, element 12).

For claim 13, please refer back to claims 1 and 8 for the explanation.

For claim 14, please refer back to claim 7 and 8 for the explanation.

For claim 15, Lazzouni teaches the system further comprising a server for storing the at least one alphanumeric character (column 2, lines 40-67).

Referring to claim 20, please refer back to claim 1 for the explanation.

For claim 21, Lazzouni further teaches the method wherein the step of determining that the at least one detected position relates to an entry of configuration data comprises identifying a portion of the address pattern adjacent to the electronic reading device as corresponding to a configuration entry form (FIG. 4; FIG. 5A-5D and column 10, lines 66-67).

Regarding claim 22, please refer back to claim 5 for the explanation.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni U.S. Patent No. 5,652,412 as applied to claim 1 above, and further in view of Bi U.S. Patent No. 5,990,875.

Regarding claim 9, Lazzouni is not explicitly teaches an identification code. Bi teaches a pen-based computer system that utilizes identification code (password protection) (FIG. 40a). Modifying Lazzouni's method of electronic reading device according to Bi would able to provide the security to the configuration. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Bi.

For claim 10, Bi futher teaches an address of a server (node address) used for authenticating configuration of the electronic reading device (FIG. 51, element 14002).

Referring to claim 11, Lazzouni teaches the transmitter for transmitting the configuration setting to a support server (host computer) (column 9, lines 15-27).

For claim 12, Lazzouni further teaches the electronic reading device wherein the transmitter transmits information via one of a cable (Ethernet) and a local wireless link (column 9, lines 15-27 and column 3, lines 5-8)

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8. Claims 16-19 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni U.S. Patent No. 5,652,412 as applied to claim 13 above, and further in view of Bi U.S. Patent No. 5,990,875.

Regarding claim 16, Lazzouni does not explicitly teach the comparing of alphanumeric character with a stored identification code. Bi teaches a pen-based computer system that compares alphanumeric character with a stored identification code (password matching) (FIG. 40a, elements 1312 and 1320). Modifying Lazzouni's method of electronic reading device according to Bi would be able to further increase the security protection by using password comparison configuration. This would improve processing and therefore, it would have been obvious to one of the ordinary skill in the art to modify Lazzouni according to Bi.

Regarding claim 17, Bi further teaches the use of the electronic reading device when the at least one alphanumeric character matches the stored identification code (FIG. 40a, elements 1320, 1322, and 1314).

Regarding claims 18-19, please refer back to claim 12 for the explanation.

Regarding claims 23, please refer back to claims 13, 16 and 17 for further explanation.

9. Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Lazzouni U.S. Patent No. 5,652,412 and Bi U.S. Patent No. 5,990,875.

Regarding claim 24, Lazzouni teaches an electronic reading device comprising:

A formatted surface having an address pattern (FIG. 4 and FIG. 5A-5D), wherein a position relative to the address pattern can be determined from an examination of a portion of the address pattern (FIG. 9).

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An electronic reading device including a reading sensor for detecting portions of the address pattern (column 2, lines 60-67); and

A first processor for translating detected portions of the address pattern into a data entry (column 4, lines 30-50).

Lazzouni does not teach the processor for comparing the data entry to a stored user identifier and for enabling the electronic reading device if the data entry corresponds to the stored user identifier. As discussed in claims 13, 16 and 17, Bi further teaches a pen-based computer system that uses a processor for comparing the data entry to a stored user identifier and for enabling the electronic reading device if the data entry corresponds to the stored user identifier (please refer back to claims 13, 16 and 17 for the teaching concepts). Modifying Lazzouni's method of electronic reading device according to Bi would be able to further increase the security protection by using password comparison configuration. This would improve processing and therefore, it would have been obvious to one of ordinary skill in the art to modify Lazzouni according to Bi.

Regarding claim 25, Lazzouni uses the same processor to perform various means (column 3, lines 51-52). Thus, it would have been obvious to one skilled in the art to apply the first and the second processor to be the same processor to save cost and utilize the processor more efficiently.

Regarding claim 26, please refer back to claim 5 for the explanation.

For claim 27, Lazzouni further teaches the system wherein the data entry and the stored user identifier represent a handwritten signature (column 3, lines 26-34).

Regarding claim 28, please refer back to claim 9 for further explanation.



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For claim 29, please refer back to claim 1 and claim 24 for the explanation.

For claim 30, please refer back to claim 5 for the explanation.

For claim 31, please refer back to claim 27 for the explanation.

For claim 32, please refer back to claim 28 for the explanation.

### ***Double Patenting***

10. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

11. Claims 1-4, 7, 11-12, 18-19, and 20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6, 9, 12-35, 43, 49, 57, and 60 of Tillgren U.S. Patent No. 6,611,259. Although the conflicting claims are not identical,

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they are not patentably distinct from each other because the subject matters disclosed in the application is substantially similar to the subject matters disclosed in the U.S. Patent No. 6,611,259.

Regarding claim 1, Tillgreen teaches a client device to receive data identifying the detected portion of the address pattern. This is obvious that this client device would include a processor to perform these claimed processes. In addition, application description can be interpreted as configuration setting. Tillgren further teaches this concept in claim 43.

Similarly to claims 2-4, by interpretations, Tillgreen also shows the configuration area, configuration form and memory to store the configuration setting. Also, it would have been obvious for one skilled in the art to have the memory storage to store the configuration setting.

Referring to claim 7, Tillgreen teaches this claimed concept in claims 12-18.

Regarding claims 11-12, please refer back to claims 6 and 35 for the teaching. Transmitting information or sending data are similar by interpretation. Plus, Wireless Application Protocol (WAP) is the concept of local wireless link.

Regarding claims 18-19, please refer back to claims 11-12 for the explanation.

For claim 20, please refer back to claim 1 for the explanation.

## CONCLUSION

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The following patents are cited to further show the state of the art with respect to electronic reading device and configurations:

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U.S. Pat. No. 6,307,955 to Zank, teaches electronic signature management system.

U.S. Pat. No. 5,793,301 to Patterson, teaches assured two-way wireless communication system.

U.S. Pat. No. 6,054,990 to Tran, teaches computer system with handwriting annotation.

U.S. Pat. No. 5,623,345 to Merchant, teaches facsimile communication with a selective call system.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian Q Le whose telephone number is 703-305-5083. The examiner can normally be reached on 8:30 A.M - 5:30 P.M.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9306 for regular communications and 703-872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to TC Customer Service whose telephone number is 703-306-0377.

BL  
December 4, 2003



**SAMIR AHMED  
PRIMARY EXAMINER**